

REMARKS

Applicants acknowledge receipt of the Examiner's Advisory Action dated September 27, 2006. The Advisory indicates that Applicants request for reconsideration was considered, but does not place the application in condition for allowance. Applicants respectfully request the Examiner's reconsideration in light of the following.

The First Non-Statutory Obviousness-Type Double Patenting Rejection

Claims, 1, 5, 9, 13, 14, and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, and 12 of U.S. Patent No. 7,028,156 (the '156 Patent) in view of U.S. Patent Publication No. 2004/0205298 filed by Bearden et al. ("Bearden"). The instant application is a continuation-in-part of the '156 Patent.

As noted in Applicant's Response to Final Office Action, MPEP 804 states, "Before consideration can be given to the issue of double patenting, two or more patents or applications must have at least one common inventor and/or be either commonly assigned/owned or noncommonly assigned/owned but subject to a joint research agreement as set forth in 35 U.S.C. § 103(c)(2) and (3) pursuant to the CREATE Act." Applicants then argued in their response to Final that Bearden does not meet this qualification, and cannot be used in a double patenting rejection. The Advisory Action, in reply, states that Bearden was used by the Examiner to establish that claims 1, 5, 9, 13, 14, and 18 of the instant application are variations of claims 1, 9, and 12 of the '156 Patent. Applicants wish to point out that Bearden was cited in the Final Office Action for more than attempting to establish that the claims of the instant application are variation of claims of the '156 Patent; Bearden was cited as teaching limitations of claims 1, 5, 9,

13, 14, and 18 that were missing in claims 1, 9, and 12 of the '156 Patent. For example, with reference to claim 1, the Final Office Action asserts that the last limitation is not found in the corresponding '156 claim, but can be found in paragraph [0029] of Bearden. Applicants again assert that use of Bearden in the double patenting rejection is improper under MPEP 804.

The Provisional Non-Statutory Double Patenting Rejection

Claims 1-6, 9-11, 13, and 18 both were provisionally rejected on the ground of nonstatutory double patenting over claims 1-4, 8, 14-17, and 23 of copending application No. 10/742,129 ("the '129 Application") in view of Bearden. As noted above, MPEP 804 requires Bearden to have a common inventor with the instant application or Bearden must be either commonly assigned/owned or noncommonly assigned/owned but subject to a joint research agreement before Bearden can be considered in a double patenting rejection. Bearden does not meet these qualifications as argued in Applicant's Response to Final Rejection. The Advisory Action, in reply, asserts that Bearden was cited to establish that claims 1-6, 9-11, 13, and 18 of the instant application are variations of claims 1-4, 8, 14-17, and 23 of the '129 Application. Applicants assert that Bearden was cited against the pending claims for more than merely establishing the claims as a variation of claims of the '129 Application; Bearden was cited as teaching limitations of claims 1-6, 9-11, 13, and 18 that were missing in claims 1-4, 8, 14-17, and 23 of the '129 Application. For example, with respect to claim 1, the Final Office Action asserts that a limitation missing in the corresponding claim of '129 patent application can be found in paragraph [0004] of Bearden. See Final Office Action paragraphs 12 and 15. Applicants assert that Bearden cannot be employed to provisionally reject claims 1-6, 9-11, 13, and 18 on the ground of nonstatutory double patenting.

The Second Non-Statutory Double Patenting Rejection

Claims 1, 5, 6, 9, and 18 were provisionally rejected on the ground of nonstatutory double patenting over claims 24, 25, 32, and 41 of copending application number 11/242,216 (“The ‘216 Application”) (Now U.S. Patent No. 7,096,332). The Advisory Action asserts that all limitations of claims 1, 5, 6, 9, and 18 are recited in claims 24, 25, 32, and 41 of the ‘216 Application. Applicants reassert their arguments set forth in the response dated August 29, 2006. Additionally, Applicants note that all recited limitations of, for example, claim 1 are not found in claim 24 as alleged in the Final Office Action. For example, claim 1 of the instant application recites reading data from a first mirror of a data volume and reading data from a second mirror of the data volume. Claim 24 (now claim 3 of the ‘322 Patent) does not recite reading data from a first mirror of a data volume and reading data from a second mirror of a data volume. Rather, claim 24 (now claim 3 of the ‘322 Patent) recites reading data from a first memory configured to store a data volume and reading data from a second memory configured to store a mirrored copy of the data volume. Claim 24 (now claim 3 of the ‘322 Patent) does not recite reading data from mirrored copies of a data volume.

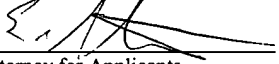
Even if claim 24 (now claim 3 of the ‘322 Patent) recited reading data from first and second mirrors of a data volume, claim 1 of the instant application is nonetheless patentably distinguishable. In other words, presuming that all the limitations of claim 1 of the instant application are taught in claim 24 (now claim 3 of the ‘322 Patent), Applicants assert that the claims are patentably distinguishable since claim 24 (now claim 3 of the ‘322 Patent) contains additional limitations not taught in claim 1 of the instant application. Domination and double patenting should not be confused. They are two separate issues.

One patent or application "dominates" a second patent application or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application.

Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection. See MPEP 804 II. In the Advisory Action, the Examiner is merely asserting domination of claim 1 of the instant application or claim 24 (now claim 3 of the '322 Patent). Without more, this rejection cannot stand.

CONCLUSION

Applicants submit that all claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop <u>AF</u> , Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia, 22313-1450, on <u>November 6, 2006</u> .	
 _____ Attorney for Applicants	<u>11/6/06</u> _____ Date of Signature

Respectfully submitted,



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